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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,688	02/26/2002	Edward Wilhelmus Mijdam	LA-7143-102.US	1471

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EXAMINER

CARTER, MONICA SMITH

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 03/28/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,688

Applicant(s)

MIJDAM ET AL.

Examiner

Monica S. Carter

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5-8, 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims ~~5~~ and 7, it is not clear what is meant by "displaced from said die cut labels."

Claims 13 and 14 depend from claims 10 and 11, respectively. Claims 13 and 14 are method claims whereas claims 10 and 11 are product claims. Claims 13 and 14 appear to be incorrectly depending from claims 10 and 11. For the purpose of prosecution, the examiner considers claims 13 and 14 to depend from claim 12.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 5, 7, and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jenkins (5,902,440) in view of Driesten et al. (EPO 1,026,215).

Jenkins discloses a label package comprising a plurality of die cut labels (18a-18e) adhesively secured (16) to a carrier (12); and a protective cover (30a-30e) adhesively secured (28) over the die cut labels.

Jenkins discloses the claimed invention except for an adhesive securing the protective cover to the die cut labels such that when the cover is removed, the adhesive leaves no tacky residue on the cover or the labels.

Driesten et al. disclose dry peel laminates comprising a face layer (1), a dry peel adhesive (9) and a liner (5) such that when the face layer is removed from the liner layer, the face material as well as the liner material "have non-sticky surfaces which are dry to the touch." (see ABSTRACT). The dry peel label laminates are generally used in manufacturing dry tags, coupons, hanger labels, or the like. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Jenkins's invention to include a dry peel adhesive, as taught by Driesten et al., to provide a stable release force over time.

Regarding claim 2, see the above rejection.

Regarding claims 5 and 7, it would have been obvious to one having ordinary skill in the art at the time the invention was made to position the dry peel adhesive at any desired location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Regarding claim 9, see the above rejections.

Regarding claims 12 and 14, Jenkins, as modified by Driesten et al., inherently disclose the method of making a shielded label package as set forth in the above rejections.

5. Claims 3, 4, 6, 8, 10, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jenkins in view of Driesten et al. and further in view of Ko et al. (5,308,887).

Jenkins, as modified by Driesten et al., discloses the claimed invention except for the dry peel adhesive being cured by exposure to ultraviolet radiation. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113) However, Ko et al. disclose pressure-sensitive adhesives that are radiation curable. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Jenkins's invention to include radiation curable adhesives, as taught by Ko et al., as an alternative method of making the pressure sensitive adhesive.

Regarding claims 4 and 11, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired material for the adhesive as deemed necessary by the end user, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose labels and radiation curable adhesives.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

March 24, 2003

Monica S. Carter
MONICA CARTER
PATENT EXAMINER